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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,598	03/12/2001	Van Diep Nguyen	155603-0209	9288
1622	7590	09/28/2004	EXAMINER	
IRELL & MANELLA LLP 840 NEWPORT CENTER DRIVE SUITE 400 NEWPORT BEACH, CA 92660			SHARON, AYAL I	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/805,598	NGUYEN ET AL. <i>[Signature]</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Ayal I Sharon	2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 March 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/5/2002</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Introduction*

1. Claims 1-31 of U.S. Application 09/805,598 filed on 03/12/2001 are presented for examination. The application claims foreign priority to French application 0011584 filed on 09/12/2000.
2. Duplicate sets of claims 1-9, differing only in font size, were filed on 3/12/2001 and 7/13/2001. Examiner's examination is based on the set filed on 7/13/2001.
3. Applicants added claims 10-31 in a preliminary amendment filed on 09/11/2001.

### *Claim Interpretations*

4. Examiner notes that there is no effect on the scope of the claims resulting from the use, in the claims, of reference characters that correspond to elements recited in the detailed description and the drawings. See MPEP §608.01(m).
5. Examiner interprets the term "couple" according to Merriam Webster's Collegiate Dictionary, 10<sup>th</sup> Ed. (2001), p.265: "to join for combined effect", and "to fasten together".
6. Examiner interprets that when a "second body" is "coupled" to a "first body", they are "joined for combined effect" and therefore the two are functionally equivalent to the "first body" alone. Likewise, when the "second body" is "coupled" to a

"base", they are "joined for combined effect" and therefore the two are functionally equivalent to the "base" alone.

***Claim Objections***

7. Claims 1-2 and 5-9 are objected to because of the following informalities:  
bulleted lists of limitations using dashes and/or dots (of varying sizes) are used in the claims. Standard U.S.P.T.O. practice is the use of lettered or numbered lists, or indented paragraphs. Appropriate correction is required.
8. Applicant is advised that should claims 26-28 be found allowable, claims 29-31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. This also applies to claims 10-13 and their duplicate claims 18-21. This also applies to claims 14-17 and their duplicate claims 22-25.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 5 and 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claim 8 recites the limitation " The process as claimed in claim 1 for displacing on a base mounted elastically with respect to the floor ...". There is insufficient antecedent basis for this limitation in the claim. There is no reference to a "floor" in claim 1.

### ***Claim Rejections - 35 USC § 101***

11.35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

The specification recites, for example, the following benefit of the claimed invention (see p.6, lines 13-17) that:

It will be noted moreover that, by reason of this combined control of said moveable unit and of said moving elements, one obtains an extremely accurate displacement of the moveable unit in a reference frame independent of the base and tied for example to the floor.

However, the benefits claimed in the specification are not substantial because the specification does not define a "real world use" for the claimed invention.

(According to MPEP §2107.01(I), a "substantial utility" defines a "real world" use).

In contrast, the Desailly et al. reference, U.S. Patent 6,438,461 (see col.3, lines 60-63) provides "real world uses" for that claimed invention.

13. Claims 1-31 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

14. In order to expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 are further rejected as set forth below.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Independent claims 10 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,438,461. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

- a. Claim 6 of the issued patent has the following limitation, which claims 10 and 18 of the current application lack:

“... the force profile being dependent on parameters related to said base and said body, said parameters vary as said body moves from the start to end positions.”

Therefore the narrower issued claim reads upon the broader claims in the application.

- b. Claims 10 and 18 of the current application claim “a second body”, which is not claimed in the issued patent’s claim 6, however, “the second body” is not referred to in the remainder of the claim, (unlike the “first body” and the “actuator”) and therefore Examiner interprets that it performs no functional purpose.
- c. Examiner also notes that Fig. 1 of the issued patent (which shows the issued invention), and Fig.1 of the application (which shows the claimed invention) are identical.

17. Independent claims 14 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,438,461. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

- a. Claim 12 of the issued patent has the following limitation, which claims 14 and 22 of the current application lack:

“... the force profile being dependent on parameters related to said base and said body, said parameters vary as said body moves from the start to end positions.”

Therefore the narrower issued claim reads upon the broader claims in the application.

- b. Claims 14 and 22 of the current application claim “a second body”, which is not claimed in the issued patent’s claim 12, however, “the second body” is not referred to in the remainder of the claim, (unlike the “first body” and the “actuator”) and therefore Examiner interprets that it performs no functional purpose.
- c. Examiner also notes that Fig. 1 of the issued patent (which shows the issued invention), and Fig.1 of the application (which shows the claimed invention) are identical.

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. The prior art used for these rejections is as follows:

20. Desailly et al., U.S. Patent 6,438,461. (Henceforth referred to as “**Desailly**”).

21. The claim rejections are hereby summarized for Applicant’s convenience. The detailed rejections follow.

22. **Claims 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Desailly.**

23. The Desailly patent has a different inventive entity than the examined application, and therefore it qualifies as prior art under 35 U.S.C. 102(e).

24. In regards to Claim 9, Desailly teaches the following limitations:

9. A device comprising:

- a base (2);

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

- a moveable unit (4) which may be displaced linearly on said base (2); and

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

- a controllable actuator (5) able to apply a force (F) to said moveable unit (4) with a view to its displacement on said base (2),

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

wherein it furthermore comprises means (6) which implement steps a) to e) of the process specified under claim 1, so as to calculate a force (F) which may be applied to said moveable unit (4) and which determine a control command and transmit it to said actuator (5) so that applies the force (F) thus calculated to said moveable unit (4).

(See Desailly, especially: Fig.1, col.4, lines 19-57)

25. In regards to Claim 10, Desailly teaches the following limitations:

10. (NEW) A device, comprising:

a base;

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

a first body coupled to said base;

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

a second body coupled to said first body;

(See Claim Interpretations)

an actuator coupled to said body; and,

(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

a computer that provides a control command to said actuator, said control command induces a force profile that causes said first body to move from a start position at a start time to an end position at an end time, so that said base has a zero displacement at the end time.

(See Desailly, especially: Fig.1, col.4, lines 19-57)

26. In regards to Claim 11, Desailly teaches the following limitations:

Art Unit: 2123

11. (NEW) The device of claim 10, wherein the force profile is dependent upon an intermediate variable and derivatives of the intermediate variable.  
(See Desailly, especially: col.3, lines 5-10; col.5, lines 38-44)

27. In regards to Claim 12, Desailly teaches the following limitations:

12. (NEW) The device of claim 10, wherein said second body has a zero displacement at the end time.  
(See Desailly, especially: col.8, lines 18-20 and lines 48-50)

28. In regards to Claim 13, Desailly teaches the following limitations:

13. (NEW) The device of claim 10 further comprising elastic mounts coupled to said base.  
(See Desailly, especially: col.1, lines 15-18 and lines 35-38; col.3, lines 65-67)

29. In regards to Claim 14, Desailly teaches the following limitations:

14. (NEW) A device, comprising:  
a base;  
(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

a first body coupled to said base;  
(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

a second body coupled to said first body;  
(See Claim Interpretations)

an actuator coupled to said body; and,  
(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

calculation means for generating a control command to said actuator, said control command induces a force profile that causes said first body to move from a start position at a start time to an end position at an end time, so that said base has a zero displacement at the end time.

(See Desailly, especially: Fig.1, col.4, lines 19-57)

30. In regards to Claim 15, Desailly teaches the following limitations:

15. (NEW) The device of claim 14, wherein the force profile is dependent upon an intermediate variable and derivatives of the intermediate variable.  
(See Desailly, especially: col.3, lines 5-10; col.5, lines 38-44)

31. In regards to Claim 16, Desailly teaches the following limitations:

16. (NEW) The device of claim 14, wherein said second body has a zero displacement at the end time.  
(See Desailly, especially: col.8, lines 18-20 and lines 48-50)

32. In regards to Claim 17, Desailly teaches the following limitations:

17. (NEW) The device of claim 14, further comprising elastic mounts coupled to said base.  
(See Desailly, especially: col.1, lines 15-18 and lines 35-38; col.3, lines 65-67)

33. **Claims 18-21 are rejected based on the same reasoning as claims 10-13**

supra. Claims 18-21 differ from claims 10-13 in that the “second body” is “coupled to the base” in the former, and “coupled to the first body” in the latter. See the “Claim Interpretations” section of this Office Action for discussion on this issue.

34. **Claims 22-25 are rejected based on the same reasoning as claims 14-17**

supra. Claims 22-25 differ from claims 14-17 in that the “second body” is “coupled to the base” in the former, and “coupled to the first body” in the latter. See the “Claim Interpretations” section of this Office Action for discussion on this issue.

35. In regards to Claim 26, Desailly teaches the following limitations:

26. (NEW) A method for moving a first body relative to a base,  
(See Desailly, especially: Fig.1, and col.3, line 55 to col.4, line 10)

wherein a second body is coupled to the first body, comprising:  
(See Claim Interpretations)

calculating a control command to move the first body relative to the base; and exerting a force onto the first body, the force having a force profile that causes the first body to move from a start position at a start time to an end position at an end time, so that the base has a zero displacement at the end time.  
(See Desailly, especially: Fig.1, col.4, lines 19-57)

36. In regards to Claim 27, Desailly teaches the following limitations:

27.(NEW) The device of claim 26, wherein the force profile is dependent upon an intermediate variable and derivatives of the intermediate variable.  
(See Desailly, especially: col.3, lines 5-10; col.5, lines 38-44)

37. In regards to Claim 28, Desailly teaches the following limitations:

28. (NEW) The device of claim 26, wherein said second body has a zero displacement at the end time.  
(See Desailly, especially: col.8, lines 18-20 and lines 48-50)

**38. Claims 29-31 are rejected based on the same reasoning as claims 26-28**

**supra**. Claims 29-31 differ from claims 26-28 in that the “second body” is “coupled to the first body” in the former, and “coupled to the base” in the latter. See the “Claim Interpretations” section of this Office Action for discussion on this issue.

***Conclusion***

39. Claims 1-8 contain patentable subject matter. Examiner would favorably consider these claims if their 35 U.S.C. §101 and 35 U.S.C. §112 rejections were to be overcome.

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone numbers are (703) 306-0297 [*Before Oct. 25, 2004*] and (571) 272-3714 [*After Oct. 25, 2004*]. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kevin Teska can be reached at (703) 305-9704 [*Before Oct. 25, 2004*] and (571) 272-3716 [*After Oct. 25, 2004*].

Any response to this office action should be faxed to (703) 872-9306 or  
mailed to:

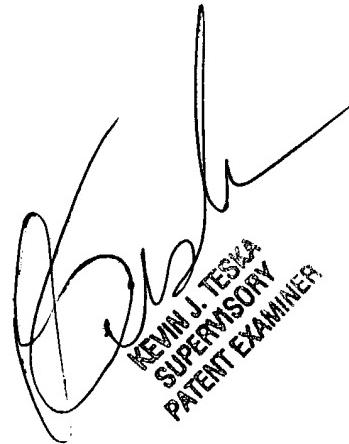
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Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the Tech Center 2100 Receptionist, whose  
telephone number is (703) 305-3900 [*Before Oct. 25, 2004*] or (571) 272-2100  
[*After Oct. 25, 2004*].

Ayal I. Sharon

Art Unit 2123

September 17, 2004



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